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| LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023 | | | EXAMINER NATNITHITHADHA, NAVIN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,005

Applicant(s)

COHEN ET AL.

Examiner

NAVIN NATNITHITHADHA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 277, 279-286, 288-301, 316 and 317 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 277, 279-286, 288-301, 316 and 317 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The status of the claims is as follows:
Claims 277 and 279 are currently amended;
Claims 280-286, 288-301, and 316 were previously presented;
Claim 317 was added; and
Claims 1-276, 278, 287, and 302-315 have been cancelled.

Response to Arguments

2. Applicant's arguments, see Remarks, pp. 5-8, filed 10 December 2007, with respect to the rejection of claims 277, 287, 288, 291-301, and 316 under 35 U.S.C. 103(a) as being unpatentable over Conrad, U.S. Patent No. 2,816,997 A ("Conrad"), in view of Woodard et al, U.S. Patent No. 5,984,711 A ("Woodard"), have been fully considered, and are persuasive. The rejection of claims 277, 287, 288, 291-301, and 316 has been withdrawn.
3. Applicant's arguments, see Remarks, pp. 5-8, filed 10 December 2007, with respect to the rejection of claims 280-285, 289, and 290 under 35 U.S.C. 103(a) as being unpatentable over Conrad in view of Woodard, as applied to claim 277 above, and further in view of Skubitz et al, U.S. Patent No. 5,851,226 A ("Skubitz"), have been fully considered, and are persuasive. The rejection of claims 280-285, 289, and 290 has been withdrawn.

4. Applicant's arguments, see Remarks, pp. 5-8, filed 10 December 2007, with respect to the rejection of claim 286 under 35 U.S.C. 103(a) as being unpatentable over Conrad in view of Woodard, as applied to claim 277 above, and further in view of Delfino et al, U.S. Patent No. 6,129,658 A ("Delfino"), have been fully considered, and are persuasive. The rejection of claim 286 has been withdrawn.

Inventorship

5. In view of the papers filed 03 October 2007, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding the following previously unnamed person as inventor of this application: Nir Betser.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 277, 279-286, 288-301, and 316-317 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what the Applicant means by "medical functionality". Is this phrase in reference to measuring pressure in a bodily cavity? See Applicant's Specification, p 20, ll. 2-9. It appears that "implantable circuitry for measuring pressure in the patient's body" would provide clarity in the subject matter.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 277, 288, 291-301, and 316 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson, U.S. Patent No. 5,508,476 A ("Dickenson"), in view of Itoigawa et al, U.S. Patent No. 5,807,265 A ("Itoigawa").

Claims 277, 288, 291, and 292: Dickenson teaches the following:

an apparatus 1, comprising:

circuitry 2;

a lead wire 8; and

a hollow tube 6, which is entirely electrically-conductive (made of conductive copper) and is soldered directly to the circuitry 2, and which hollow tube 6 is mechanically coupled to the lead wire 8 so as to be electrically coupled thereto (see col. 2, ll. 17-51).

Dickenson teaches the apparatus 1 is a mounting arrangement for semiconductor devices, but does not teach that apparatus 1 is a medical apparatus comprising implantable circuitry, having medical functionality, which is adapted to be placed in the patient. However, Itoigawa teaches a medical apparatus 1 for placement in a patient (see fig. 1) comprising: a pressure sensor including a semiconductor pressure sensor chip/circuitry 6 that is implanted using a catheter 2 and used for measuring pressure within the body of a patient (see col. 1, ll. 6-10, and col. 3, ll. 1-6 and 28-40). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Dickenson's semiconductor device to be a semiconductor pressure sensor chip as taught by Itoigawa because Dickenson provides fatigue-free external connections to a device.

Claims 293-301: These claims appear to be alternative species of the "implantable circuitry" that are not critical to Applicant's invention. Since Itoigawa teaches a pressure sensor chip 6, Itoigawa teaches one of the species claim 292 and the generic claims 291 and 297 (sensor can be considered an active element for "actively" sensing a parameters, such as temperature).

Claims 316: This claim contains subject matter regarding a process for manufacturing the apparatus of claim 277 and does not further limit the structural elements of claim 277. Thus, Dickenson anticipates the structural limitations of claim 316.

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8. Claims 279 and 317 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Itoigawa, as applied to claim 277 above, and further in view of Woodard et al, US 5,851,226 A ("Woodard").

Claim 279 and 317: Dickenson in view of Itoigawa does not teach the hollow tube is crimped to the lead wire. However, Woodard teaches catheter 10 comprising crimping a hollow tube ("conductive tube") 30 that is crimped to a lead wire ("electrode wire") 16 so as to be mechanically coupled thereto (to frictionally engage the electrode wire," see col. 4, ll. 27-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Conrad's tube 80 to be crimped to the lead wire 76 in order to provide improved connection between a wire from an electrophysiology device, such as Conrad's implantable thermometer catheter, and a conventional wires leading to external circuitry (see col. 2, ll. 15-44).

9. Claims 280-285, 289, and 290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Itoigawa, as applied to claim 277 above, and further in view of Skubitz et al, US 5,851,226 A ("Skubitz").

Claims 280-285, 289, and 290: Dickenson in view of Itoigawa does not teach the lead wire 274 comprises MP35N, platinum/iridium, alloys having low iron content (i.e. 1-60%, 1-40%, or 1-20% iron by weight), or silver and the connector is coated with gold or comprises steel. However, Skubitz teaches "outer conductor 55 may optionally comprise wires formed of a nickel-titanium alloy such as NITINOL.TM. [i.e. MP35N] , platinum, gold, silver, palladium, other noble metals, and other alloys [i.e. steel] or

metals suitable for use in the human body. NITINOL.TM. may be purchased from Fort Wayne Metals of Fort Wayne, Ind.” (see col. 16, ll. 51-62). In fact, Applicant’s disclosure, on page 7, lines 27-32, admits that “these materials have proven to be both safe and effective for many applications in the human body”. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Dickenson’s lead wire 76 (or Weinand’s lead wire 12) and hollow tube 80 to comprise the materials of claims 280-284 and 289 because these materials are well known in the art to be suitable materials for use in the human body, as stated by Skubitz (see col. 16, ll. 51-62).

10. Claim 286 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Itoigawa, as applied to claims 277 above, and further in view of Delfino et al, US 6,129,658 A (“Delfino”).

Claim 286: Dickenson in view of Itoigawa does not teach that the hollow tube 76 has been treated with phosphoric acid. However, Delfino teaches using phosphoric acid solutions for treating implantable medical apparatuses (see col. 2, ll. 35-36). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to treat Dickenson’s tube with phosphoric acid because Delfino discloses that “Metal-phosphate coating processes using phosphoric acid solutions are also known for depositing coatings of to prevent corrosion, lubricate, prolong the life of metal surfaces, and improve paint coating adhesion” (see col. 2, ll. 35-36).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **NAVIN NATNITHITHADHA** whose telephone number is (571)272-4732. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Marmor, II/
Supervisory Patent Examiner
Art Unit 3735

/N. N./
Patent Examiner, Art Unit 3735
04/11/2008